



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

CHARLES J. BARBAS
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVE.
BOSTON, MA 02210

COPY MAILED

AUG 18 2005

OFFICE OF PETITIONS

In re Application of :
Zhang et al. :
Application No. 09/345,193 :
Filed: June 30, 1999 : ON PETITION
Attorney Docket Number: :
112025-0138 :
:

This Decision is in response to the Request for Reconsideration of Petition to Correct Filing Date, filed August 2, 2005. The correspondence is properly treated as a petition under 37 CFR 1.53.

The petition is dismissed.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.53." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application, including 31 pages of specification and 17 claims, and 7 drawing sheets, was filed on June 30, 1999. Applicant filed a Petition to Correct Filing Date on April 28, 2004, and asserted that the specification filed with the application on June 30, 1999, refers to and incorporates by reference a second application; however, the second application was not filed until July 1, 1999¹. Applicant

¹ The specification in the above-identified application refers and seeks to incorporate by reference to a "co-pending U.S. Patent Application Ser. No. [] entitled A Protocol to Coordinate Network End Points to Measure Network Latency...", when in fact no co-pending U.S. Patent Application entitled A Protocol to Coordinate Network End Points to Measure Network Latency, existed on June 30, 1999. See, *In re Glass*, 492 F.2d 1228, 181 U.S.P.Q. (BNA) 31 (C.C.P.A. 1974).

argued that, because the second application describes the preferred embodiment of an aspect of the present application, the second application contains material that is essential to the specification of the above-identified application. As such, Applicant argues, the above-identified application was incomplete for purposes of obtaining a filing date.

In a Decision dismissing the petition mailed February 17, 2005, Applicant was advised that 37 CFR 1.53 provides that the filing date of an application "is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office." The MPEP reiterates 37 CFR 1.53(b) and provides that "[t]he filing date to be accorded such an application is the date on which all of the requirements of 37 CFR 1.53(b) are met.

Applicant was informed that, for purposes of receiving a filing date, the above-identified application was complete on the day that the specification a description and claims (31 pages), and 7 drawing sheets, were filed in this Office.

The instant petition

Applicant files the instant Request for Reconsideration and admits that the papers filed on June 30, 1999 entitled applicants to a filing date. Applicant argues that pages and figures were missing from the submitted materials. Because the pages and figures were missing from the application as filed, Applicant argues that he should have the opportunity to submit the omitted or missing pages and figures and receive as a filing date the date the omitted or missing pages and figures are submitted. Applicant seeks to analogize the instant situation to one where an application is filed without all of the pages of the specification. In such a situation, this Office mails a Notice of Omitted Items in accordance with MPEP 601.01(d), and an applicant is given the option of submitting the omitted or missing pages and/or figures and accepting the date of the submission as the filing date of the application.

Analysis and conclusion

Applicant's arguments are not well taken. It is initially noted that 601.01(d) is applicable only when the Office of Initial

Patent Examination ("OIPE") has reviewed application papers and determined the application has been filed without all of the page(s) of the specification [but does containing something that can be construed as a written description, at least one drawing figure, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim]. Here, applicant filed 25 consecutively numbered pages of specification, 5 consecutively numbered pages of claims, and 7 sheets of drawings containing Figures 1A, 1B, 2, 3A, 3B, 4 and 5, all of which were referenced in the specification. All of the pages of the specification were filed on June 30, 1999, and there was no need to mail a "Notice of Omitted Items" indicating that the application papers so deposited have been accorded a filing date, but are lacking some page(s) of the specification, because all of the pages of the specification were present on filing. As such, section 601.01(d) of the MPEP was not invoked. Applicant was not mailed a Notice of Omitted Items and Applicant was not given the option of submitting any omitted or missing pages and/or figures and accepting the date of such submission as the filing date of the application.

Similarly, the MPEP 601.01(g) provides that (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification.

Here, all of the figures of the drawings that were mentioned in the specification were present in the application.

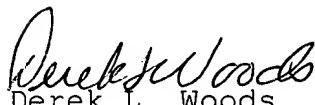
The application was complete for purposes of obtaining a filing date; however, applicant sought to supplement the disclosure by reference to an application that was not in existence at the time the above-identified application was filed. In essence, applicant sought to supplement the disclosure by a later publication. There are numerous examples wherein an application was complete for purposes of receiving a filing date but later

the applicant attempted to supplement the disclosure of the application. In the Decision dismissing Applicant's original petition, this Office noted in a footnote *In re Glass*, 492 F.2d 1228, 181 U.S.P.Q. (BNA) 31 (C.C.P.A. 1974). There, as here, Appellant had filed his application and, as here, received a filing date. Appellant there attempted to use the disclosure of patents which issued after his filing date. Similarly here, Applicant's are attempting to use the disclosure of an application filed after their filing date. The court in *Glass* posited that "[i]f a disclosure is insufficient at the time it is filed, can it be made sufficient, while the application is still pending, by later publications which add to the knowledge of the art so that the disclosure, supplemented by such publications, would suffice to enable the practice of the invention?" *Glass* at 1232. The *Glass* court answered in the negative. The court held that "[t]he sufficiency must be judged as of the filing date." *Id.* See, also, *White Consol. Indus., Inc. v. Vega Servo-Control, Inc.*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974).

Here Applicant seeks to conflate the completeness of an application for purposes of obtaining a filing date with the sufficiency of an application's disclosure. As can be seen in the cases *supra*, an application may be found complete for purposes of obtaining a filing date while at the same time have an incomplete disclosure. Such is the case here.

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Director's decision will be based solely on the administrative record in existence.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney
Office of Petitions